

REMARKS/ARGUMENTS

Claim Rejections § 112

Indefinite

The second paragraph of 35 U.S.C. §112 states the following:

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention”

Claims 1-7 and 23-27 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner indicated that the use of the open language “comprises” permits any number of other nucleotides or either end of the specific sequence. Thus, these unknown regions may not be specific for the second PCR DNA products, but may nonspecifically hybridize. Therefore, the Examiner stated that it is unclear how one distinguishes such nonspecific hybridization from the specific hybridization due to the only known sequence.

In addition, claims 3, 11-14, 21 and 22 were also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action stated that the uses of the open language “comprises” make it unclear how one distinguish PCR products due only to the specified sequences and those which may be due solely to the unknown regions of the primer.

The applicant hereby makes amendments to the claims in view of the Examiner’s comments in response to the above-mentioned claim rejections. The open language “comprises”

used in claims 1, 3 and 11 has been replaced with the term “consisting of” to overcome the cited rejections.

The amended claims 1, 3 and 11 are sufficient to render the present invention patentable. Claims 2, 4-7, 12-14 and 21-27 are dependent from their respective independent claims, whereby should be patentable for the same reasons stated above.

Patent Examiners Should Interpret Claims in Light of Specification

The court has recently indicated that the PTO should apply the principles of *Phillips v. AWH* during prosecution — rather than the PTO’s current practice of giving claims their “broadest reasonable interpretation.” *In re Johnston* (Fed. Cir. 2006). The Patent Office may use a dictionary in defining the patent applicant’s claim terms only when the patent specification did not otherwise provide any interpretation.

Request For Allowance

Claims 1-7, 11-14 and 21-27 are pending in this application. The applicant expresses his gratitude to the Examiner for the courtesies extended to the applicant’s undersigned representative throughout prosecution of this application. In view of the foregoing, the applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested. Favorable consideration is respectfully requested.

Respectfully submitted,
WPAT, P.C.

By /Anthony S. King/
Anthony S. King
Registration No. 49063
April 3, 2009

WPAT, P.C.,
World Patent and Trademark Law Group
2030 Main Street, Suite 1300
Irvine, CA 92614
Telephone (949) 260-4797 Fax (949) 260-4798